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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,158	02/27/2004	Philip F. Spalding JR.	026818-000100US	8979
20350 7590 03/15/2011 KILPATRICK TOWNSEND & STOCKTON LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
LUBIN, VALERIE				
ART UNIT		PAPER NUMBER		
3626				
NOTIFICATION DATE		DELIVERY MODE		
03/15/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/789,158

Applicant(s)

SPALDING, PHILIP F.

Examiner

VALERIE LUBIN

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

2. Claims 15-27 are pending.

For reference purposes, the document paper number is 20110306.

Response to Amendment

3. The rejection of claims 15-27 under 35 U.S.C. 112 first paragraph is maintained.
4. A rejection under 35 U.S.C. 112 second paragraph is introduced for claims 15-27.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 15-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Independent claim 15 recites a "server computer", for which Applicant's disclosure does not provide any support.

Claims 16-27 are rejected under the above analysis.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 15-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Amended claim 15 recites "whose original policy owners are willing or may become willing" and "policies being tracked that are potentially available for sale..." The quoted language states what may be possible as opposed to what is. Examiner is unable to ascertain the metes and bounds of such ambiguous language as it does not positively recite any action or fact. For examining purposes, "whose original policy owners are willing or may become willing" shall be interpreted as "whose original policy owners are willing..." and "policies being tracked that are potentially available for sale..." shall be interpreted as "policies available for sale."

Claims 16-27 are rejected under the above analysis.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman U.S. Patent No. 2001/0034619 in view of Lange Pre-Grant Pub No. 2004/0064391.

13. With respect to claim 15, Sherman recites a method comprising the steps of providing a database comprising information concerning a plurality of in-force life insurance policies (§

10 "web sites", 44); obtaining via a web-based interface financial and medical underwriting information about in-force policies from their original policy owners (§ 10, 24) and storing underwriting information in the database (§ 10); categorizing by a computer underwriting information electronically (§ 10) and tracking by the computer membership records pertaining to accessing the database (§ 45). The language "as to allow...to create a listing of in-force policies available for sale..." is intended use language that does not result in additional steps, and hence does not further limit the claim. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

Sherman recites locating by the computer policies whose owners are willing to entertain offers to buy additional policies (§ 46). He does not recite owners who want to sell their policies to potential buys, but Lange discloses owners selling their policies to potential buyers (§ 25). It would therefore have been obvious to one of ordinary skill in the art to add the teachings of Lange to Sherman with the motivation of locating policies for which the owners want to sell their policies in order to meet the needs the buyers and sellers.

14. For claim 16, Sherman recites granting access to the database (§ 45).

15. For claim 17, Examiner showed that the combination of Sherman and Lange recites identifying owners who want to sell their insurance policies. Sherman and Lange do not specifically disclose generating electronic messages to sellers advising them of an opportunity to sell; however, Examiner takes Official Notice that generating or triggering messages to advise sellers of opportunities was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to

combine the prior art to include the generation of electronic messages in order to advise sellers and buyers of opportunities to transact.

Claims 23 and 26 are rejected under the above analysis.

16. With respect to claim 18, Sherman recites information including personal information (§ 45).

17. Claim 19 is rejected, as Sherman discloses an online environment including a website (§ 10).

18. For claim 20, Examiner takes Official Notice that maintaining auctions on a website for insurance policies was old and well known in the art at the time of the invention. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman with that of the prior art in order to obtain more competitive prices on insurance policies.

19. For claim 21, Sherman recites a service of appraising in-force life insurance policies (§ 18, 48).

20. For claim 22, Sherman recites providing policy own policy owners who might want to buy additional insurance access to underwriting information (§ 45). He does not specifically recite providing access to potential buyers of the owners' insurance policies, but Lange recites owners selling their policies. It would therefore have been obvious to one of ordinary

skill in the art to combine the teachings of Sherman and Lange to provide access to insured parties who not only want to buy additional insurance, but also who want to sell their insurance and to parties interested in buying those policies in order to facilitate transacting.

21. For claim 24, Sherman and Lange does not specifically recite tracking policies, but Examiner takes Official Notice that such a step was old and well known in the art at the time the invention was made. It would have been obvious to one of ordinary skill to combine the prior art to track policies in order to monitor their performance and determine whether it would be beneficial to sell or buy them.

22. For claim 25, Examiner takes Official Notice that reminding insurance owners to pay their premium was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art to issue reminders to owners to pay premium in order to provide them with enough time to submit their payment and to keep their policies in proper standing.

23. For claim 27, Sherman recites allowing an owner to agent to enter information about a policy (§ 46). Sherman does not disclose calculating an approximate face value of the policy, but Lange does (§ 36). It would have been obvious to one of ordinary skill in the art to combine the teachings of Sherman and Lange to calculate the face value of a policy in order to determine the value realized by selling it. Sherman recites buying additional insurance policies (Abstract) and Lange discloses owners selling their insurance policies (§ 25). Sherman and Lange do not specifically recite displaying potential savings realized in

premiums by selling a policy and buying new one at a lower premium; however Examiner takes Official Notice that displaying or reporting savings data was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Sherman and Lange with the prior art to display savings realized in premiums from selling a policy and buying a new one in order to help a buyer determine how beneficial it would be to trade policies.

Response to Arguments

24. As stated in office action mailed on 12/22/2008, the following assertions of fact have gone unchallenged and are considered admitted prior art:

- generating or triggering messages to advise sellers of opportunities;
- maintaining auctions on a website for insurance policies;
- tracking policies and reminding insurance owners to pay their premium;
- displaying or reporting savings data.

25. Applicant's arguments filed 5/11/2009 have been fully considered but they are not persuasive.

26. With regards to the 112, first paragraph, Applicant argues that the disclosure of an internet website containing a database and a webpage is sufficient for one of ordinary skill in the art to recognize at the time the application was filed, that Applicant's invention "was referring to an implementation that could be embodied in a web software running on a web server." Examiner agrees that the recitation of a website and/or webpage suggests the use

of a computer to access data; however such recitation does not necessarily imply that a server computer is performing some of Applicant's limitations such as the "locating", "categorizing" and "tracking" steps of claim 15 for example.

27. Applicant argues that "there does not appear to be any disclosure or suggestion in Sherman for obtaining information about the in-force policies from their original policy owners, as needed, and storing it in the database for evaluation by the potential buyers". First, Sherman recites obtaining via a web-based interface financial and medical underwriting information about in-force policies from their original policy owners (§ 10, 24 "may obtain underwriting information from insured parties and provide primary and secondary life insurance plans") and storing underwriting information in the database (§ 10). With regards to Applicant's argument that "In Sherman, the insured parties under the primary insurance plan are the buyers of the secondary insurance plan, not the sellers of the primary insurance plan" Examiner reasserts as in the previous office actions that Lange discloses such a teaching in § 25 "Insured may desire to sell their policies..."

28. Applicant argues the prior art does not recite a "server computer electronically categorizing financial and medical information to create a list of in-force policies available for sell. First Examiners refers to Sherman's Abstract and Fig. 1 which show a computer system. Second, Examiner refers Applicant to Sherman § 10 where it is disclosed that an electronic database categorizing and storing underwriting information to allow parties to acquire life insurance. Also see § 43. Additionally, the language "as to allow...to create a listing of in-force policies available for sale..." is intended use language that does not result in

additional steps, and hence does not further limit the claim. See Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Weiss et al. U.S. Patent No. 6,904,410 recites generating electronic messages to notify buyers/sellers of potential opportunities and meeting desired criteria.

b) Hanby et al., U.S. Patent No. 7,143,051 discloses clients being alerted via email of insurance proposals.

c) Kendall et al., U.S. Pre-Grant Pub No. 2002/0091613 discloses online auctions on insurance policies, and requesting a demonstration of a replacement policy valuation.

d) Ariathurai et al., Pre-Grant Pub No. 2002/0198743 discloses tracking insurance policies.

e) Deavers, U.S. Patent No. 6,044,352 discloses notifying clients of an upcoming premium due data and amount.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Thursday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on 571-272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. L./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Primary Examiner, Art Unit 3626